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13) Group Art Unit 1635

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January 2, 2002

(Date)

Ginger R. Dreger, Reg. No. 33,055

Examiner : Nguyen, Lien-Chi A

## RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents  
Washington, D.C. 20231

Claims 27-52 are pending in this application. In an Office Action mailed on December 4, 2001 (Paper No. 21) and setting a one-month term, applicants were requested to elect, for examination purposes, one of the following groups: Group I (claims 27-46 and 52), Group II (claims 47-49), and Group III (claims 50 and 51). According to the Office Action, "[i]nvention I is related as product and process of use to inventions II and II, respective," and "[e]ach of groups II and III is drawn to materially different processes involving distinct and separate considerations."

The claims of Group I (claims 27-46 and 52) are hereby elected, with traverse.

Prior to the issuance of the present restriction requirement, this application had received two Office Actions on the merits (Paper Nos. 13 and 16), each containing numerous rejections concerning all claims pending. The rejections raised in Paper No. 16 were addressed in the Second Preliminary Amendment and Response filed on September 28, 2001, which included the cancellation of original claims 1-11 and 13-26, the amendment of original claim 27, and the submission of new claims 28-52. Although claims 47-49, and 50-51 were newly submitted, similar claims (claims 18-22 and claim 13) were present in the original claim set, and were never

Appl. No. : 09/214,371  
Filed : March 26, 1999

subject to a restriction requirement. It is, therefore, surprising that applicants would receive a restriction requirement at this late stage of prosecution, concerning claims that were already examined on the merits.

37 C.F.R. § 1.142(a) states: "[i]f the distinctness and independence of the invention be clear, such requirement will be made before any action upon the merits; however, it may be made at any time before final action in the case at the discretion of the examiner." The present application already received a final Office Action, mailed on March 13, 2001, before applicants filed a Request for Continued Examination on September 28, 2001. Therefore, the issuance of a restriction requirement at this stage of prosecution is believed to be improper. Furthermore, the Examiners are encouraged to make a restriction requirement, "as soon as the need for a proper requirement develops." (M.P.E.P. 811) Nothing that has happened during the prosecution of this application raises any new issues of unity, therefore, there have been no developments that would establish a need for a restriction requirement.

Since the examination of all claims in the present application does not place any additional burden on the Examiner, law and fairness require that applicants be allowed to have all claims pending examined in the present application. This is particularly true, since the present application is a national phase application of a prior PCT application, therefore, the unity standard of PCT Rule 13.1 applies. Applicants submit that all claims pending in the present application are so linked as to form a single general inventive concept, and should be examined in one application.

Although no fees are believed to be due at this time, please charge any fees, including any fees for extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: January 2, 2002

By: Ginger R. Dreger  
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GP 11635  
PATENT

Case Docket No. MEWB27.001APC

Date: January 2, 2002

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In re application of : Lane et al.  
App. No. : 09/214,371  
Filed : March 26, 1999  
For : INHIBITORS OF THE  
INTERACTION  
BETWEEN P53 AND  
MDM2  
Examiner : Nguyen, Lien-Chi A  
Art Unit : 1635

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COMMISSIONER FOR PATENTS  
WASHINGTON, D.C. 20231

Sir:

Transmitted herewith is a RESPONSE TO RESTRICTION REQUIREMENT in the above-identified application.

The fee has been calculated as shown below:

CLAIMS AS FILED						
	CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NO. PREVIOUSLY PAID FOR	PRESENT EXTRA	RATE	ADDITIONAL FEE
Total Claims	21	—	25	= x	\$18	= \$0
Independent Claims	4	—	9	= x	\$84	= \$0
If application has been amended to contain multiple dependent claim(s), then add					\$280	= \$0
Time Extension Fee						\$0
TOTAL ADDITIONAL FEE FOR THIS AMENDMENT						\$0

(X) Return prepaid postcard.

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Ginger R. Dreger  
Registration No. 33,055  
Attorney of Record